

ESTTA Tracking number: **ESTTA443624**Filing date: **11/29/2011**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Petition for Cancellation**

Notice is hereby given that the following party requests to cancel indicated registration.

**Petitioner Information**

Name	UFC ULTIMATE FITNESS CENTER, LLC.		
Entity	LLC	Citizenship	California
Address	1380 3RD AVE Chula Vista, CA 91911 UNITED STATES		

Attorney information	Elizabeth Oliner Raj Abhyanker PC 1580 West El Camino Real Mountain View, CA 94040 UNITED STATES liz@rajpatent.com Phone:6503906409
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**Registration Subject to Cancellation**

Registration No	3999175	Registration date	07/19/2011
Registrant	Zuffa, LLC 2960 W. Sahara Avenue Attention: Legal Department Las Vegas, NV 89102 UNITED STATES		

**Goods/Services Subject to Cancellation**

Class 041. First Use: 2009/12/01 First Use In Commerce: 2009/12/01 All goods and services in the class are cancelled, namely: Providing health club services, namely, providing fitness and exercise facilities; instruction services, namely, instruction in the field of health and physical fitness; educational services, namely, instruction and training in the fields of fitness and nutrition; instruction programs in the field of health and physical fitness, namely, providing exercise classes for groups of individuals; Providing information in the field of fitness and mixed martial arts training via a global computer network
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**Grounds for Cancellation**

False suggestion of a connection	Trademark Act section 2(a)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Priority and likelihood of confusion	Trademark Act section 2(d)
Other	priority of use by petitioner

Related Proceedings	92054704
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**Mark Cited by Petitioner as Basis for Cancellation**

U.S. Application No.	85126538	Application Date	09/10/2010
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	UFC ULTIMATE FITNESS CENTER THE GYM THAT FITS YOUR LIFE!		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1996/05/15 First Use In Commerce: 1996/05/15 Health club services, namely, providing instruction and equipment in the field of physical fitness, exercise, boxing, kick boxing and mixed martial arts		
Attachments	85126538#TMSN.jpeg ( 1 page )( bytes ) UFCGYMcancellation.pdf ( 6 pages )(2032484 bytes )		

### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Elizabeth Oliner/
Name	Elizabeth Oliner
Date	11/29/2011

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

*In the Matter of Registration Number: 3,999,175*

UFC ULTIMATE FITNESS CENTER,  
LLC  
Petitioner,

Cancellation No.  
Registration No. 3,999,175

v.

Zuffa, LLC  
Registrant

**PETITION TO CANCEL**

UFC ULTIMATE FITNESS CENTER, LLC (“Petitioner”) believes that it is, or will be damaged by U.S. Trademark Registration No. 3,999,175 for UFC granted to Zuffa, LLC, (“Registrant”) and therefore files this petition for cancellation of this registration in its entirety. As grounds for the cancellation, Petitioner, by its attorneys at Raj Abhyanker PC, alleges as follows:

1. Petitioner is a limited liability company, incorporated in the state of California, with an address at 1380 Third Avenue in Chula Vista, CA 91911.
2. Petitioner is the owner of the pending US trademark application Serial No. 85,126,538 filed on September 9, 2010 for UFC ULTIMATE FITNESS CENTER THE GYM THAT FITS YOUR LIFE! for “Health club services, namely, providing instruction and equipment in the field of physical fitness, exercise, boxing and mixed martial arts” in International Class 041
3. Upon information and belief, Registrant is a Limited Liability Company (LLC) in the state of Nevada with an address at 2960 W. Sahara Avenue in Las Vegas, NV 89102.
4. Registrant is the owner of US trademark Registration No. 3,999,175 for UFC GYM for “providing health club services, namely, providing fitness and exercise facilities; instruction services, namely instruction in the field of health and physical fitness;

educational services, namely instruction and training in the fields of physical fitness and nutrition; instruction programs in the field of health and physical fitness, namely providing exercise classes for groups of individuals; Providing information in the field of fitness and mixed martial arts training via a global computer network” in International Class 041. This trademark was originally filed as an “intent-to-use” or “1(b)” application on December 15, 2008.

5. Petitioner’s UFC ULTIMATE FITNESS CENTER THE GYM THAT FITS YOUR LIFE! mark received a Non-Final Office Action from the United States Trademark and Patent Office on December 23, 2010 citing a potential likelihood of confusion with Registrant’s UFC GYM mark (Registration No. 3,999,175) .
6. Petitioner’s UFC ULTIMATE FITNESS CENTER THE GYM THAT FITS YOUR LIFE! mark received suspension notices on February 4, 2011 and April 14, 2011, upholding the potential likelihood of confusion with Registrant’s UFC GYM mark (Registration No. 3,999,175)
7. Registrant’s UFC GYM mark (Registration No. 3,999,175) was registered on July 19, 2010.
8. Based on the aforementioned facts, Petitioner has standing to bring this cancellation proceeding.

#### **PETITIONER’S PRIORITY OF USE**

9. Petitioner repeats and realleges the allegations of the preceding Paragraphs as if fully set forth herein.
10. Petitioner has been using UFC ULTIMATE FITNESS CENTER THE GYM THAT FITS YOUR LIFE! mark in connection with its Ultimate Fitness Center facility offering health club services in Chula Vista, California since as early as May 15, 1996.
11. Petitioner is the owner of the following live websites: [www.ultimatefitnesscenters.org](http://www.ultimatefitnesscenters.org) and [www.ultimatefitnesscenterchulavista.com](http://www.ultimatefitnesscenterchulavista.com), both of which have been registered since as early as 2008. The UFC ULTIMATE FITNESS CENTER THE GYM THAT FITS YOUR LIFE! mark clearly appears on both of the websites.

12. Petitioner has expended considerable time, effort and financial resources building and marketing the UFC ULTIMATE FITNESS CENTER THE GYM THAT FITS YOUR LIFE! brand.
13. Registrant is the owner of numerous federally filed trademarks include the combination of “UFC” and “ULTIMATE FIGHTING CHAMPIONSHIP” and has historically used the acronym “UFC” to refer to the phrase “ULTIMATE FIGHTING CHAMPIONSHIP.”
14. Registrant’s trademark registration for UFC GYM in International Class 041 cites December 1, 2009 as the date of first use in commerce and anywhere.
15. Petitioner has been using the UFC ULTIMATE FITNESS CENTER THE GYM THAT FITS YOUR LIFE! mark in commerce in relation to “health club services” for a significantly longer period of time than Registrant has used its UFC mark for “health club services.” Petitioner has never abandoned its mark. Petitioner has continuously used and is using UFC ULTIMATE FITNESS CENTER THE GYM THAT FITS YOUR LIFE! for health club services in International Class 41.

#### FALSE CONNECTION WITH PETITIONER

16. Petitioner repeats and realleges the allegations of the preceding Paragraphs as if fully set forth herein.
17. Over the past 14 years that Petitioner has been in business as a gym/health club facility, consumers have come to associate the term dominant term “UFC” for “health club services” solely with Petitioner, such that the term “UFC” for “health club services” points uniquely to Petitioner as an entity.
18. On information and belief, Registrant is the owner of the live Internet website [www.ufcgy.com](http://www.ufcgy.com) and is now using the term UFC GYM to refer to health club services.
19. When confronted with this website and with Registrant’s UFC GYM mark for “health club services,” consumers will assume a false connection exists between Registrant’s services and Petitioner’s health club services and/or Registrant’s use of the term UFC GYM would be taken by the public as an endorsement by Petitioner of Registrant’s services used in connection with the Registrant’s mark. Further, any defect, objection



or fault found with Registrant's services provided under Registrant's mark would necessarily reflect upon and seriously injure Petitioner's reputation.

20. The use of the term "UFC" or "UFC GYM" in class 041 when applied to health club or gym services offered by the Registrant, falsely suggest a connection with Petitioner within the meaning of Section 2(a) of the Trademark Act.
21. Upon information and belief, and on the results of an investigation conducted by Petitioner and Petitioner's attorneys, Registrant has used and/or continues to use the phrase UFC gym with the specific intent to appropriate the substantial goodwill and recognition associated with Petitioner's health club services, and with the specific intent to falsely suggest a connection with Petitioner.

#### FRAUD BY REGISTRANT

22. Petitioner repeats and realleges the allegations of the preceding Paragraphs as if fully set forth herein.
23. On information and belief, and on the results of an investigation conducted by Petitioner and by Petitioner's attorneys, Registrant made false, material representations of fact in procuring Registration No. 3,999,175 with an intent to defraud the Patent and Trademark Office and to obtain a registration to which it was otherwise not entitled.
24. Prior to filing its application for UFC GYM in class 041, Registrant knew and was fully aware of Petitioner's right to use the nearly identical mark in commerce. Specifically, Registrant knew of and was aware of several members from the fighting community who belonged to Petitioner's gym facility at the time when Registrant applied for its trademark application for UFC GYM in class 041. Furthermore, prior to filing its application for UFC GYM in class 041, Registrant knew of and was aware that Petitioner's gym had also sponsored some fighters affiliated with Zuffa.
25. Nonetheless, Registrant falsely and fraudulently signed a sworn statement with the USPTO saying that to the best of Registrant's "knowledge and belief, no other person, firm or corporation has the right to use said mark in commerce in either the identical form or in such near resemblance thereto as may be likely, when applied to

the goods or services of such other person, to cause confusion, to cause mistake, or to deceive.”

HARM TO PETITIONER

26. Petitioner repeats and realleges the allegations of the preceding Paragraphs as if fully set forth herein.
27. Registrant's use of UFC with class 041 gym or health club service and/or any reference by Registrant referring to UFC as a “Ultimate Fitness Center” or “Ultimate Fitness Experience” is likely to cause deception as to the origin of Registrant's services. Consumers are likely to believe that Registrant's services are somehow affiliated, associated, or endorsed by Petitioner, which is false.
28. Registrant's likely to cause harm to damage to the good will and reputation that Petitioner has been building since 1996.

WHEREFORE, Petitioner prays that Registration No. 3,999,175 be cancelled.

Respectfully submitted,

Elizabeth Oliner, Esq.  
Raj Abhyanker PC  
1580 West El Camino Real  
Mountain View, CA 94110  
[liz@rajpatent.com](mailto:liz@rajpatent.com)  
650 390 6409

Signature: \_\_\_\_\_

Dated: 11/29/2011

CERTIFICATE OF SERVICE

I hereby certify that on this 29th day of November, 2011, a copy of the attached Petition to Cancel has been served on the Registrant, by mailing a copy thereof, first class, postage prepaid to:

- 1) Zuffa, LLC at 2960 W. Sahara Avenue in Las Vegas, NV 89102
- 2) Their attorneys, Michael N. Feder and Sarah Ko Craft at Gordon Silver Ltd at 3960 Howard Hughes Parkway 9<sup>th</sup> Floor in Las Vegas, Nevada 89169,



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Elizabeth Oliner, Esq.